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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,616	12/30/2003	Kothapalli Venkata Raju	C261 1040.1	2874
26158 7590 02/18/2010 WOMBLE CARLYLE SANDRIDGE & RICE, PLLC ATTN: PATENT DOCKETING P.O. BOX 7037 ATLANTA, GA 30357-0037				
			EXAMINER	
			CHEN, VIVIAN	
		ART UNIT	PAPER NUMBER	
		1794		
		MAIL DATE	DELIVERY MODE	
		02/18/2010 PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,616

Applicant(s)

RAJU ET AL.

Examiner

Vivian Chen

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 3, 5-20 have been cancelled by Applicant

Specification

2. The amendment filed 10/27/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the omission of the NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2 from the coating compositions recited in amended claim 1, because the disclosure as originally filed appears to require the presence of the above three components in the formulations I and II (see published application paragraph 0028-0029) and therefore does not provide support for coating compositions of type I or II which do not contain the said three omitted components;

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The amendment filed 10/15/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendments in the specification changing HAPCO™ NXZ to NOPCO™ NXZ. The disclosure as originally filed only discloses HAPCO™ NXZ and contains no discussion as to the function of HAPCO™ NXZ that would

lead one of ordinary skill in the art to reasonably believe that the mention of HAPCO™ NXZ was intended to refer to NOPCO™ NXZ.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention in objection under U.S.C. 132(a) to the amendment filed 10/27/2006. The disclosure as originally filed appears to require the presence of NILSET™ 117, HAPCO™ NXZ (or NOPCO™ NXZ), and BORCHI® GOI E2 in the coating composition formulations I and II (see published application paragraph 0028-0029) of the claimed invention(s), and therefore does not provide support claims reciting coating compositions of type I and II which do NOT contain the said three omitted components.

Claim Rejections - 35 USC § 103

6. The rejections under 35 U.S.C. 103(a) based on KYMINAS ET AL (US 4,749,731) and KADAMBANDE ET AL (US 6,627,700) and WEINMANN ET AL (US 6,395,845) have been withdrawn in view of Applicant's Amendments filed 10/15/2009.

7. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

WU (US 3,997,694) or WU (US 3,943,187),

in view of SHANTON (US 5,776,619),

and in view of WO 99/23179 (WO '179).

The WU references disclose coatings suitable for direct food contact (i.e., food safe), wherein the coating comprises 25-50 wt% binder with said binder comprising 5-40 wt% of an epoxy resin, 1-15 vol% pigment (e.g., titanium dioxide), and 2-8 vol% of an extending pigment (e.g., talc) (WU '694, line 1-8, col. 2; line 7-57, col. 4; line 10-20, col. 5, etc.) (see corresponding portions of WU '187) However, the reference does not explicitly disclose the claimed calcined clay.

SHANTON discloses that it is well known in the art to use mixtures of food grade pigments (e.g., titanium dioxide, talc, calcined clay, etc.) in food contacting coatings in order to provide attractive coloration to food packaging and food service articles. (line 1-9, col. 6; claim 28)

WO '179 discloses that it is well known in the art to use calcined clay as an extender for white or near white pigment compositions containing titanium dioxide in order to reduce material costs. (line 14-32, page 7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a food safe coating as disclosed in the WU references to form durable protective films for food containers. It also would have been obvious to incorporate a second known food safe extender pigment (i.e., calcined clay) in combination with talc in the coating compositions of the WU references in order to obtain specific visual effects with reduced material costs. One of ordinary skill in the art would have incorporated effective amounts of known non-toxic functional coating additives conventionally used in the coating art to enhance the performance of coating compositions (e.g., to prevent foaming, control viscosity, modify surface-tension, maintain uniform dispersion of fillers and pigments, etc.) (claims 22-25) in the compositions of the WU references in order to improve the coating characteristics of the composition and the physical properties of the resultant coating. The Examiner has reason to believe that the vol% ranges of pigment disclosed in the WU references are inclusive of the wt% range recited in claim 21, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

8. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over:
WU (US 3,997,694) or WU (US 3,943,187), in view of SHANTON (US 5,776,619),
and in view of WO 99/23179 (WO '179),
as applied to claim 21,
and further in view of CHRISTENSON ET AL (US 4,335,829).

CHRISTENSON ET AL discloses that it is well known in the art to incorporate known additives such as flow control agents, surfactants, and other formulating additives to food-grade

coatings in order to enhance and modify the performance of coating compositions. (lines 35-38, col. 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use effective amounts of known non-toxic functional additives conventionally used in the coating art to enhance the performance of coating compositions (e.g., to prevent foaming, control viscosity, modify surface-tension, maintain uniform dispersion of fillers and pigments, etc.) (claims 22-25) in the compositions of the WU references in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

Response to Arguments

9. Applicant's arguments filed 10/15/2009 have been fully considered but they are not persuasive.

(A) Applicant argues that the disclosure as originally filed provides support for the coating compositions as presently recited in claim 1 which omit NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2. However, while the specification provides support for a coating composition which does not require these three compounds, that formulation is deemed to be distinct from the formulation(s) of claim 1, which are the formulations of type I and II (see paragraphs 0028 and 0029 in the published application). The coating compositions as recited in claim 21 and described in paragraph 0027 in the published application differs from the compositions as presently recited in claim 1 on several significant points (e.g., with respect to the relative amounts of talc with respect to the amount of resin, titanium dioxide, calcined clay, etc.), and therefore does not provide support for the compositions as presently recited in claim 1.

(B) Regarding the outstanding rejections under 35 USC 112, first paragraph, based on the usage of trademarks and/or tradenames, and the objections to the amendments to the specification filed 10/27/2006 and 10/15/2009 under 35 U.S.C. 132(a) , said rejections and objections remain outstanding because the specification as originally filed fails to provide *any* information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art. Although Applicant argues that the function and/or general composition of NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2 are known in the art, generalized statements in Applicant's arguments are not adequate, especially when such compounds are apparently highly region-specific. Such information should be present as objective evidence (e.g., in the form of declarations, dated product documentation, etc.) for the record.

With respect to NILSET™ 117 and BORCHI® GOI E2, Applicant has not provided sufficient dated evidence on the record as to the generic identity of the above compounds at the time the invention was made.

With respect to HAPCO™ NXZ, Applicant's argues that one of ordinary skill in the art would understand that Applicant was referring to NOPCO™ NXZ are not deemed persuasive because the disclosure as originally filed only discloses HAPCO™ NXZ with no discussion as to the intended function or generic composition of HAPCO™ NXZ. Therefore, because of the lack of any information in the disclosure as originally filed as to the intended function or composition of HAPCO™ NXZ, there is no persuasive evidence why one of ordinary skill in the art would automatically understand that the HAPCO™ NXZ was actually intended to refer to NOPCO™ NXZ.

(c) Applicant's arguments with respect to claims 21-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 12, 2010

/Vivian Chen/

Primary Examiner, Art Unit 1794